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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91239589
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UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

MAKER'S MARK DISTILLERY, INC.,

Opposer,

v.

BOWMAKER'S WHISKEY COMPANY,

Applicant.

Opposition No. 91239589

Serial No. 87,383,989

Mark: BOWMAKER'S WHISKEY

REPLY BRIEF OF OPPOSER
MAKER'S MARK DISTILLERY, INC.

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Pursuant to 37 C.F.R. § 2.128 and TBMP § 801, Opposer Maker's Mark Distillery, Inc. respectfully submits this reply brief in response to Applicant Bowmaker's Whiskey Company's Trial Brief filed on May 11, 2021 ("Applicant's Brief") (51 TTABvue) and in furtherance of Opposer's request that the Board refuse registration of United States Application Serial No. 87,383,989 for the standard character mark BOWMAKER'S WHISKEY in class 33 for use in connection with "distilled spirits; whiskey; bourbon."

I. INTRODUCTION

Applicant's Brief (i) fails to address central arguments raised in Opposer's Opening Brief (49 TTABvue) with respect to the similarity of the parties' marks and the conditions under which sales of the competing goods will be made, (ii) concedes that Opposer's marks are very well known and that the parties' goods and channels of trade are identical, and (iii) distracts the Board by mischaracterizing evidence and placing undue emphasis on allegedly similar third-party marks that are mostly abandoned or cancelled, and therefore of no consequence.

II. ARGUMENT

A. Applicant Fails to Address Key Arguments Made by Opposer with Respect to the Similarity of the Parties' Marks and the Conditions Under Which Sales of the Covered Goods are Made.

Applicant's Brief does not rebut numerous arguments made in Opposer's Opening Brief with respect to *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) factors 1 (similarity of the parties' marks) and 4 (conditions under which sales of the covered goods are made). These factors favor Opposer.

1. The Parties' Marks Share the Identical Dominant Term MAKER'S.

Applicant does not address, and therefore concedes, the argument that MAKER'S is the dominant portion of Opposer's marks. Applicant's Brief similarly does not address Opposer's argument that the Contested Mark incorporates the dominant MAKER'S element of Opposer's

marks in its entirety, a fact that the Applicant has tried at various times to avoid, but cannot meaningfully dispute.¹ As noted in Opposer’s Opening Brief, “[t]o the average buyer, the points of similarity”—in this case the identical dominant term MAKER’S—“are more important than minor points of difference”—here the addition of “BOW.” 4 McCarthy on Trademarks and Unfair Competition § 23:41 (5th ed. 2018); *see also In re Chatam Int’l Inc.*, 380 F.3d 1340, 1343, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“Viewed in their entireties with non-dominant features appropriately discounted, the marks GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila become nearly identical”). This is particularly true where, as here, Opposer has developed numerous brand extensions,² such that “even if consumers were to notice the difference between [the marks],” they “might well think” that BOWMAKER’S is a variant of Opposer’s marks. *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914 (T.T.A.B. 2000) (sustaining opposition against application to register the trademark YO-YO’S for “snack cakes,” in part because the opposer, owner of the well-known snack cake brand HOHOs, had used variations such as NUTTY HOHOs and HOHOHO, prompting the Board to conclude that consumers might view YO-YO’S as another of the opposer’s brand extensions).

2. Opposer’s Marks Are Synonymous With Opposer’s Goods, Not the Term of Art Used Among Pewter Craftsmen That Inspired Opposer’s Founders More Than 60 Years Ago.

Applicant does not challenge Opposer’s argument that, among relevant consumers, MAKER’S MARK and MAKER’S are synonymous with Opposer’s bourbon products. Opposer has submitted ample evidence to show that its marks are widely recognized as source indicators of

¹ Applicant’s responses to Opposer’s Requests for Admission (Opp. NOR 3, Ex. 9) included a blanket denial that the Contested Mark incorporates “MAKER’S” in its entirety and Mr. Parks refused to concede this point during his testimony (*see Parks Trial Test 52:24-54:6*), but clearly the characters B-O-W-M-A-K-E-R-’-S include M-A-K-E-R-’-S.

² Brand extensions include MAKER’S MARK PRIVATE SELECT, MAKER’S 46 and MAKER’S MARK CASK STRENGTH. *See Opening Brief at 18-20; Parks Trial Test 52:22-53:16; and Wagner Decl. ¶11.*

Opposer's bourbon products. This includes: (i) a 2017 brand study that determined that at least 69% of survey respondents were aware of the MAKER'S MARK brand and that MAKER'S MARK bourbon had consistently held a top-3 or top-4 spot in brand power for all whiskies in the United States,³ (ii) articles and accolades spanning from a 1980 *Wall Street Journal* cover story highlighting that MAKER'S MARK had established "superior quality with a fine image" and was "a textbook case of superior marketing" to a 2018 *Food and Wine* magazine article calling MAKER'S MARK the #1 most important bourbon ever made;⁴ (iii) statements made about the brand's cultural significance on the occasion of its distillery's designation as a national historic landmark,⁵ (iv) information about the brand's ambassador program and social media following;⁶ and (v) testimony from Applicant's own witnesses, Don Rodgers and Bryan Parks, who acknowledge that if someone were to visit a bar and ask for MAKER'S, they would be served bourbon made by Opposer.⁷ In contrast, Applicant has submitted no evidence to show that relevant consumers associate the terms MAKER'S MARK or MAKER'S with fine metalwork.

³ Applicant complains that the Kantar Millward Brown report is "survey evidence without any underlying documentation, e.g. how the percentages were derived and who the respondents were" (Applicant's Brief at 7-8), but the full report, which included detailed information on the methodology and sample size and profile, was provided during discovery. As is evident in the opening slide, the study involved 2,749 respondents aged 22-59 who had consumed whiskey during the past month, 70% of whom were male and 30% of whom were female. Phillips Dec. Ex. 1. Applicant elected not to cross examine any of Opposer's witnesses who offered this and other evidence as part of their testimony.

⁴ Applicant concedes that the Board should weigh this evidence as it sees fit despite its hearsay objections. (Applicant's Brief at 8.) The fact that Opposer and its products have so frequently been the subject of unsolicited media attention and other accolades is a testament to the brand's strength, even if only considering the evidence on its face. However, certain documents, including the *Wall Street Journal* article, meet the ancient documents exception to the hearsay rule and may be probative of facts asserted therein. *See American Express v. Darcon Travel*, 215 U.S.P.Q. 529, 1982 WL 52064, at *4 (T.T.A.B. 1982) (finding older periodicals in the record admissible hearsay under Fed. R. Evid. 803(16)).

⁵ Opp. NOR 5 Ex. 25.

⁶ Wagner Decl. ¶20 (noting Opposer has thousands of brand ambassadors); Phillips Decl. ¶34, Phillips Decl. Ex. 5 (noting that Facebook page for MAKER'S MARK, www.facebook.com/makersmark, had over 839,000 likes and over 817,000 followers as of October 21, 2020, and Opposer's Twitter account for MAKER'S MARK, www.twitter.com/makersmark, has over 133,000 followers).

⁷ Parks Trial Test 52:22-53:16; Rodgers Test. 41:24-42:2, 47 TTABVue.

In *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816 (T.T.A.B. 2015), the applicant argued that its contested WINEBUD mark was appreciably different from Anheuser-Busch's BUDWEISER and BUD marks because WINEBUD allegedly had a connotation related to viticulture, whereas Anheuser-Busch's marks connoted the German name for a town in the Czech Republic that was known for beer. The Board rejected this argument, finding it "very unlikely" that American beer drinkers perceive Anheuser-Busch's famous BUDWEISER trademark as suggesting a connotation to a town formerly known as Budweis. *Id.*, at 1816. In making this finding, the Board observed that there was no record evidence to suggest such a connection in the minds of any appreciable number of consumers and that even if certain consumers were aware of the town, applicant's argument would not apply to the BUD trademark.

Here too, there is no evidence in the record to suggest that U.S. whiskey drinkers associate the term MAKER'S MARK with the unique imprints used by pewter craftsmen rather than with Opposer and its products. The argument that consumers would do so in connection with MAKER'S is even more attenuated. Just as "BUD" did not relate to the BUDWEISER trademark's association with a town in the Czech Republic, MAKER'S has no association with the fine metal industry in any way. To the contrary, Applicant's own witnesses attest that bar patrons have a singular impression as to what the terms MAKER'S MARK and MAKER'S connote—products sold by Opposer. *See* Opening Brief at 37-38 (citing Parks Trial Test 52:22-53:16; Rodgers Test. 41:24-42:2).⁸

⁸ Applicant cites the testimony of Don Rodgers and Ruth Khalsa, who are described as "third-party unbiased witnesses," for the proposition that the parties' trademarks create different commercial impressions. (Applicant's Brief at 19). It strains credulity to believe that Applicant's paid consultant and the attorney who filed the subject application in this proceeding are neutral. Opposer reiterates its objections to the legal conclusions made during the testimony of Ms. Khalsa, who, without having personally performed any clearance search, opined that "all the *DuPont* factors" weigh against confusion, a far-fetched premise that only weakens her credibility. Khalsa Test. 88-89. Opposer further objects to Mr. Rodgers' legal conclusions and hearsay musings about his out of court discussions with "people in the industry." *See* Applicant's Brief at 12-13 (citing Rodgers Test. 51-52). This testimony consists solely of legal conclusions by non-expert witnesses and should be stricken.

Furthermore, the fact that there is a dictionary entry for “maker’s mark” that references the fine metal industry origins of the term is hardly evidence that the mark is “common,” as Applicant suggests. (Applicant’s Brief at 18.) For one, the printout from Merriam-Webster that was entered into evidence by Applicant notes that the term “maker’s mark” is in the bottom 30% of terms searched, which suggests it is more obscure than common. (Applicant’s NOR 2 Ex. 33). Additionally, in *Anheuser-Busch*, a dictionary definition showing that the term “Budweiser” is the name of a style of lager beer, similar to pilsner, from the city of České Budejovice in the Czech Republic, derived from the German name for the town, Budweis, was entered into evidence. *Anheuser-Busch*, 115 USPQ2d at 1818. However, this was not a bar to the Board finding that BUDWEISER is more commonly associated with Anheuser-Busch and its products in the minds of U.S. consumers, just as MAKER’S MARK is more commonly associated with Opposer and its products than it is with imprints left on metal.

Given the great commercial strength of MAKER’S MARK and MAKER’S, the flagship brand’s origin story has greater bearing on the first *DuPont* factor, the strength of the senior mark, than any connotations associated with the marks. As Opposer’s Opening Brief explained, at the time Opposer’s founders adopted MAKER’S MARK, the name only functioned as an archaic term used within a specialized industry generally unfamiliar to buyers. *See* Opening Brief at 36 (citing MCCARTHY, § 11:4). There is no evidence in the record that “maker’s mark” was a commonly used term at the time it was adopted; rather, it was a metalwork term randomly applied to bourbon. *Id.* Applicant does not rebut Opposer’s argument that its marks are intrinsically strong.

3. The Parties’ Trade Dress and the Stylization Applicant Intends to Use for its Word Mark are Irrelevant to the Confusion Inquiry.

Applicant’s Brief similarly does not address the argument that the parties’ marks are in standard characters and thus “could be used in any typeface, color, or size, including the same

stylization actually used . . . by the other party, or one that minimizes the differences or emphasizes the similarities between the marks.” *Anheuser–Busch* 115 USPQ2d at 1823 (citing *Citigroup II*, 98 USPQ2d at 1258-59). Instead, Applicant uses its brief to amplify its misplaced focus on alleged differences between the parties’ trade dress and labels. *See* Applicant’s Brief at 15-16 (showing a side-by-side comparison of the BOWMAKER’S WHISKEY label and a bottle of MAKER’S MARK bourbon and observing that “[t]he products look completely different.”). Analysis of the similarity between marks “is based on the marks as depicted in the respective application and registration, without regard to whether the marks will appear with other marks, such as house marks, or other elements when used.” TMEP 1207.01(b); *see also In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (T.T.A.B. 2018) (“[W]e do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application. We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information.”).

4. The Origins of Applicant’s Selection of the Contested Mark are Irrelevant if the Result is a Mark Confusingly Similar to Opposer’s.

Applicant’s Brief also fails to address Opposer’s argument that, when assessing similarity, the origins of a mark’s adoption are irrelevant if the result is a confusingly similar mark. Applicant relies on testimony that it adopted its mark because its founder has a hobby of making bows used for archery⁹, hence the “BOW” in the “BOWMAKER’S” mark. However, “[t]he derivation of a mark is of no particular significance if the end result is a mark confusingly similar to a previously registered mark.” *In re Iowa Paint Mfg. Co.*, 149 USPQ 230, 231 (T.T.A.B. 1966) (citing *Meyer*

⁹ This is one of many hobbies of Mr. Parks, who is also a pilot. Parks Discovery Dep. 16:5-21; Opp NOR 2, Ex. 5, 27 TTABVue.

Chem. Co. v. Anahist Co., 263 F.2d 344, 120 USPQ 483, 484 (C.C.P.A. 1959) (“How the mark came to be adopted is not material to the issue.”)).

In *New Era Cap Co. Inc. v. Pro Era LLC*, Opposition No. 91216455, 2020 WL 2820403 (T.T.A.B. May 29, 2020), the Board relied on this principle in refusing registration of the mark PRO ERA on the grounds that it was confusingly similar to the opposer’s senior NEW ERA mark. *New Era*, 2020 WL 2820403 at *21. The applicant had argued that the opposer’s NEW ERA mark was different in appearance, sound, connotation, and commercial impression due to inclusion of the word PRO in applicant’s PRO ERA mark and evidence that the term PRO ERA is an abbreviation for PROGRESSIVE ERA. Just as in *New Era*, where the Board found the term “PRO” could symbolize “PROGRESSIVE,” “PROFESSIONAL,” or any number of other terms, so too, the term “BOW” could be equally symbolic of an archery tool, an implement used to play string instruments, or a ribbon tied to a birthday present. It is not Applicant’s subjective intent, but rather, the perspective of the average consumer, that matters. Here, the average consumer will view BOWMAKER’S as another brand extension from Opposer. *See, e.g., Interstate Brands Corp.*, 53 USPQ2d at 1914 (applicant’s selection of YO-YO’S due to its snack cake’s resemblance to a yo-yo toy and distinctions between the connotations associated with the parties’ marks not sufficient to overcome the risk that consumers might view YO-YO’S as an extension of HOHO’S, a well-known brand used for identical, directly competitive goods that had previously used extensions such as NUTTY HOHOs and HOHOHO).

5. Purchasers of Bourbon Cannot Exercise Great Care When Ordering Orally at Bars and Restaurants, Which Is Where Opposer’s Products are Consumed Nearly Half the Time.

Regardless of the level of care a bourbon drinker might exercise when selecting a bottle in a retail establishment or online, the fact remains that confusion is highly likely in bar and restaurant settings where approximately 40% of Opposer’s goods are sold. *See Opening Brief* at 42-43 (citing

Phillips Decl. ¶27, Phillips Decl. Ex. 1). Applicant’s Brief does not address this argument at all, focusing instead solely on testimony and evidence tending to show that bourbon drinkers are discriminating and sophisticated customers. (Applicant’s Brief at 20.)

While Opposer concedes that many bourbon drinkers have discriminating taste, bourbon drinkers do not always find themselves in a carefully controlled environment where they can do extensive research or linger over their choices. Many bourbon drinkers consume bourbon at bars. While some bars may have written menus that would allow a customer to see the parties’ marks as written, a great many restaurants and bars do not have drink menus at all. The latter environments can be noisy and drink offerings are frequently presented by servers and selected by customers orally, which enhances the risk of confusion. *See Schieffelin & Co. v. The Molson Companies Ltd.*, 9 U.S.P.Q.2d 2069, 2073 (T.T.A.B. 1989) (giving weight to the fact that “the products of the parties are of the type ordered verbally [orally] in bars and restaurants” in finding the mark BRADOR for malt liquor confusingly similar to the mark BRAS D’OR for cognac brandy).

In addition, Opposer presented unrebutted testimony that consumers commonly abbreviate the MAKER’S MARK trademark into the “bar call” MAKER’S, itself a registered trademark that is well recognized by consumers. Wagner ¶10. When taking an order in a loud bar, one could easily miss the first syllable of “BOWMAKER’S” and hear “MAKER’S” instead, particularly when the latter stands for a renowned bourbon brand that is so versatile that one industry executive observed you “can’t run a bar without” it.¹⁰ A great number of the parties’ directly competitive sales will be made in bars and restaurants where courts have concluded that oral ordering makes confusion more likely. Accordingly, the conditions-of-purchase factor favors Opposer.

¹⁰ Opp. NOR 4, Ex. 15, 30 TTABVue.

B. The Level of Similarity Required to Find Likelihood of Confusion is Diminished Because Applicant Concedes the Great Strength of Opposer's Marks and that the Parties' Goods and Channels of Trade are Identical.

In Applicant's Brief, Applicant concedes that the following three *DuPont* factors favor the Opposer: factor 5 (strength of the senior mark(s)) and factors 2 and 3 (similarity of the goods and trade channels). *See* Applicant's Brief at 24 ("Opposer has alleged that the MAKER'S MARK trademarks are well known. . . Applicant does not dispute this allegation."); Applicant's Brief at 19 ("Applicant does not dispute that the parties goods and channels of trade are the same.").

As noted in the Opening Brief, it is well settled that the degree of similarity in the respective marks necessary to find likelihood of confusion is less when the goods of the parties are the same and directly competitive than when the goods were not the same.¹¹ It is also well settled that strong marks such as MAKER'S MARK and MAKER'S "enjoy a wide latitude of legal protection" and cast "a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). Given the identical nature of the goods and trade channels and the undisputed consumer recognition of Opposer's trademarks, the mere addition of "BOW" to an otherwise identical mark for identical goods is not sufficient to avoid the long shadow of Opposer's rights. There was "no excuse for even approaching" the well-known trademarks of Applicant's direct competitor,¹² which have been used continuously by Opposer for its renowned bourbon products for more than 60 years through trade channels that include bars, restaurants, and liquor stores. Wagner Decl. ¶17. Applicant admits that these are precisely the places where it hopes to one day sell its own bourbon. Parks Trial Test 17:21-18:10. This "raises 'but one inference—that of gaining advantage from the wide reputation established by

¹¹ *See In re Vittera*, 671 F.3d 1358, 101 U.S.P.Q.2d 1905, 1908 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992).

¹² *Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1074 (Fed. Cir. 1989) (internal quotations omitted).

[Opposer] in the goods bearing its mark[s.]”“ *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 676, 223 USPQ 1281, 1285 (Fed. Cir. 1984) (quoting *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 924, 134 USPQ 504, 511 (C.C.P.A. 1962)).¹³




C. Applicant’s Illusion of a Crowded Field Cannot Hide that Opposer Stands Alone as User and Registrant of MAKER’S- Formative Marks For Whiskey and Bourbon.

With respect to the sixth *DuPont* factor, the number and nature of similar marks in use on similar goods, during its testimony period, Opposer submitted un rebutted evidence that no company besides Maker’s Mark offers bourbon or whiskey for sale in the U.S. using the term MAKER or MAKER’S in its name. *See* Opp. NOR 6 Exs. 30-35; Phillips Decl. ¶60; Wagner Decl. ¶26. Rather than acknowledging this fact, Applicant resorts to creating the illusion of a crowded field of marks without indicating whether the cited marks are live, actually in use, or recognized by relevant consumers; nearly all are not, so no weight should be given to them.

Applicant’s Brief (at 21-22) includes a list of marks allegedly similar to Opposer’s. In order to provide the Board with a fuller picture of these allegedly similar marks, below is a copy of Applicant’s list showing the status of each (with corrections in red where applicable and live marks that incorporate MAKER or MAKER’S in purple italics):


TRADEMARK	REG. NO.	GOODS (SUMMARY)	STATUS
MAKER’S MARK	1,693,478	Marketing consulting services	DEAD
MAKER’S MARK	1,040,945	Dinnerware and related service pieces	DEAD
MAKER’S MARK	795,289	Men’s and Boy’s outer garments	DEAD


¹³ Applicant does not deny other evidence tending to show an intent to copy, namely that the Applicant’s founder visited Opposer’s website with its consultant in late 2016, perhaps the very same day the two allegedly ran an Internet search to “clear” use of BOWMAKER’S WHISKEY as a trademark. Parks Trial Test 47:4-25; Jenkins Trial Test 66:11-69:1. Applicant later used identical language to Opposer’s on its website, allegedly as a “placeholder.” Parks Trial Test 62:20-63:8 The notion this use was intended to be temporary is contradicted by the fact that Opposer’s counsel viewed the offending language in real time on Applicant’s live website during Mr. Parks’ deposition 4 years later and Ms. Phillips viewed it when preparing her declaration around the same time. Jenkins Test. 82:12-87:17 (“Q: Mr. Jenkins, you watched me visit the bowmakerswhiskey.com domain name; correct? A: I could barely see it, but yes...Q: And this splash page we’re looking at, that’s one that iDeed created for Bowmaker’s Whiskey Company, correct? A: That was a mock, yes.”); *Id.*, at Exhibit Maker’s Trial 16; 39 TTABVue; Phillips Decl.¶36-39.

TRADEMARK	REG. NO.	GOODS (SUMMARY)	STATUS
MAKER'S MARK	87/746,837 (never registered)	Men's skincare, grooming and beauty products	DEAD
MAKER'S TABLE	3,114,487	Alcoholic beverages, namely, wines	DEAD
MAKER'S TABLE	86/736,259 (never registered)	Wines	DEAD
<i>THE MAKER</i>	<i>4,403,990</i>	<i>Wines</i>	<i>LIVE</i>
<i>BARREL MAKER</i>	<i>4,790,239</i>	<i>Wine</i>	<i>LIVE</i>
<i>MAP MAKER</i>	<i>3,653,684</i>	<i>Wine</i>	<i>LIVE</i>
<i>MAGIC MAKER</i>	<i>4,460,225</i>	<i>Wine</i>	<i>LIVE</i>
<i>SIN MAKER</i>	<i>4,049,639</i>	<i>Alcoholic energy drinks</i>	<i>LIVE</i>
	<i>4,053,946</i>	<i>Alcoholic energy drinks</i>	<i>LIVE</i>
	<i>5,308,828</i>	<i>Alcoholic beverages</i>	<i>LIVE</i>
THE PARTY MAKER	3,651,463	Alcoholic beverages	DEAD
MAGICK MAKER	85/852,405 (never registered)	Wine	DEAD
<i>BABY MAKER</i>	<i>88/278,457</i>	<i>Wine</i>	<i>LIVE</i>
THE BABY MAKER	86/397,072 (never registered)	Wine	DEAD
BLACK MAKER	88/205,021 (never registered)	Alcoholic beverages	DEAD
MISCHIEF MAKER	86/736,259 (never registered)	Wines	DEAD
<i>MATE MAKER BEVERAGES</i>	<i>88/914,627</i> <i>(never registered)</i>	<i>Beers</i>	<i>LIVE</i>
MEMBER'S MARK	3,941,793	Alcoholic beverages	LIVE
MEMBER'S MARK	5,396,943	Alcoholic beverages	LIVE
COOPER'S MARK	4,115,536	Distilled Spirits	LIVE
OLD MARK	4,739,555	Vodka	LIVE
	4,739,553	Vodka	LIVE
GREEN MARK	3,744,765	Vodka	LIVE
SILVER MARK	4,429,720	Alcoholic beverages	DEAD
SHEPHERDS MARK	4,083,804	Wines	LIVE
VINTNER'S MARK	4,238,105	Wines	LIVE
BEAUTY MARK	5,222,540	Wines	LIVE
ROYAL MARK	1,285,527	Whiskey	DEAD
KING'S MARK	842,977	Whiskey	DEAD
FANCY MARK	600,119	Gin	DEAD
<i>EIGHTH MAKER</i>	<i>6,086,233</i>	<i>Wine</i>	<i>LIVE</i>
<i>WINE MAKER'S ESSENTIALS</i>	<i>5,044,213</i>	<i>Wine making equipment kits</i>	<i>LIVE</i>

TRADEMARK	REG. NO.	GOODS (SUMMARY)	STATUS
MEMBER'S MARK	5,396,942	Cocktail mixes	LIVE
MEMBERS MARK	2,582,569	Malt beer Fruit Juices	LIVE
<i>MARK MAKER</i>	<i>1,635,458</i>	<i>Marking products and equipment</i>	<i>LIVE</i>

As shown above, fifteen of the cited marks are no longer active. Third-party trademarks are significant not by virtue of their mere existence, but upon proof of their usage and customer awareness of the marks. See *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333 (Fed. Cir. 2001) (“[W]here the record includes no evidence about the extent of third party uses . . . [t]he probative value of this evidence is minimal”); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 325, 54 C.C.P.A. 1295 (1967) (“[T]he existence of these [third party] registrations is not evidence of what happens in the market place or that customers are familiar with their use.”). While “active” third party registrations “may” be relevant to show a mark is descriptive, suggestive or commonly used, “cancelled or expired third-party registrations for similar marks are not probative evidence.” TMEP 1207.01(d)(iii).

Of the remaining marks cited, eleven do not incorporate MAKER or MAKER’S at all. This leaves just twelve live records that incorporate one of these terms. Seven of these are for wine or wine related goods, one is for beer, two are for alcoholic energy drinks, and one is for “marking products and equipment.” Only the logo and stylized mark  (STRIKE MAKER) is for “alcoholic beverages,” a category broad enough to include Opposer’s goods.

Applicant has furnished no evidence of use of  or any of the other marks it has cited with the exception of MEMBER’S MARK, a private brand developed by and sold only at Sam’s Club. Opp. NOR 6 Exs. 37 and 38. This mark (i) does not incorporate the dominant element MAKER’S, (ii) is used for “blended Scotch whiskey” rather than bourbon (App. NOR 3 Ex. 81), and (iii) is well known by consumers as being associated with Sam’s Club, since the store uses the

MEMBER'S MARK name on hundreds of products ranging from food and beverages to general merchandise such as "apparel" and "daily essentials" for home and business use. Opp. NOR 6 Exs. 37 and 38.

Furthermore, when a mark has a high level of consumer recognition, as Applicant acknowledges for MAKER'S MARK and MAKER'S, evidence of even substantial third-party use may not diminish its strength. See 3A Louis Altman & Malla Pollack, *Callmann on Unfair Competition, Trademarks & Monopolies* § 21:80 (4th ed.). For example, in *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 U.S.P.Q.2d 1835, 1989 WL 281893 (T.T.A.B. Apr. 21, 1989), the TIFFANY mark was held to be a strong mark in the jewelry category despite evidence of 926 third-party uses. *Tiffany*, 1989 WL 281893 at *7 (finding likelihood of confusion with an automobile manufacturer's mark and pointing out that "the list of [third-party] marks does not show to what extent the companies' names or trade names were used, or whether the public is or ever was aware of the third party use of "Tiffany" as part of such names").

D. Applicant's Total Reliance on *Roederer* Misses the Mark.

Applicant's total reliance on *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ 2d 1459 (Fed. Cir. 1998), for the proposition that the Board should focus exclusively on alleged dissimilarities between the marks in sight, sound, and meaning, is a red herring. In *Roederer*, the record was "paltry" and "characterized by a lack of evidence on many of the *DuPont* factors," whereas here there is voluminous evidence favoring Opposer. In *Roederer*, the Federal Circuit chose not to disturb a finding that CRYSTAL CREEK for wine was not likely to be confused with CRISTAL and CRISTAL CHAMPAGNE for champagne. However, in that case, the applicant did not use the dominant portion of the opposer's mark, CRISTAL, in its entirety, as Applicant does here with its use of MAKER'S. The case is also inapposite because the covered goods in *Roederer* were closely related, but not identical, as they are here. (Champagne is

a particular type of sparkling wine associated exclusively with products from a specific geographic region.) “When goods are directly competitive, almost all courts will still require the use of a multi-factor analysis, and not simply compare the marks themselves for similarity.” 4 McCarthy on Trademarks and Unfair Competition, § 23:20.50 (5th ed.).

E. Any Doubt About Whether Confusion is Likely Should Be Resolved in Opposer’s Favor.

Although Opposer maintains that the evidence clearly supports barring Applicant from registering BOWMAKER’S WHISKEY for goods identical to those sold under Opposer’s famous MAKER’S trademarks, to the extent there is any doubt, the precedent is clear that such doubts are to be resolved in favor of Opposer and its MAKER’S brands because “the newcomer has the opportunity and obligation to avoid confusion with existing marks.” *In re Chatam Int’l Inc.*, 380 F.3d at 1345 (quoting *Hewlett–Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265 (Fed. Cir. 2002)). *See also Kenner Parker Toys Inc.* at 1458 (“In the event of doubts about the likelihood of confusion, the Board and this court should resolve those doubts against the newcomer.”).

III. CONCLUSION

For the reasons set forth above and in Opposer’s Opening Trial Brief, Opposer respectfully requests that the Board sustain this Opposition on the grounds of likelihood of confusion under Section 2(d) and refuse registration to Applicant.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Opposer's Reply Brief, was served via email on counsel for Applicant at the following addresses on May 28, 2021:

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